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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:
David B. Kumhyr: Before the Examiner:
: Mary Cheung

Serial No. : 09/731,628

: Group Art Unit: 3621

Filed: December 7, 2000

: Intellectual Property Law

Title: USE OF PERSONA OBJECT IN
ELECTRONIC TRANSACTIONS: IBM Corporation
: 11400 Burnet Road
: Austin, Texas 78758APPEAL BRIEFMail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**RECEIVED**
DEC 18 2003
GROUP 3600I. REAL PARTY IN INTEREST

The real party in interest is International Business Machines Corporation, which is the assignee of the entire right, title and interest in the above-identified patent application.

12/16/2003 SDENBOB1 00000050 090447 09731628
01 FC:1402 330.00 DACERTIFICATION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on December 11, 2003.

SignatureSerena Beller
(Printed name of person certifying)

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant, Appellant's legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-36 are pending in the Application. Claims 1-36 stand rejected.

IV. STATUS OF AMENDMENTS

The Appellant's response to the Office Action, having a mailing date of February 12, 2003, has been considered, but the Examiner indicated that it did not place the Application in condition for allowance because the Appellant's arguments were deemed unpersuasive.

V. SUMMARY OF INVENTION

A web site may be customized to a specific user of a client computer (hereinafter "client") when information about that client is available to the site. Specification, page 1, lines 16-17. For example, if a web site has access to a record indicating that a client is a sports fan, then the site may be specially configured to display a sports advertisement whenever that client accesses the site. Specification, page 1, lines 17-20. Such functionality can encourage sports sponsors for the web site, consequently increasing site revenue. Specification, page 1, lines 20-21.

To that end, the World Wide Web may utilize "cookies" to provide client information, e.g., user's regular interest or buying habits, to a web site. Specification, page 2, lines 1-2. As is known in the art, a cookie is a data block that is transmitted to a client browser by a web site. Specification, page 2, lines 2-3. Upon receipt, the browser stores the cookie in a given manner such as, for example, in a text file called "cookie.txt." Specification, page 2, lines 4-5. The cookie may then be transmitted back to the web site each time the browser requests access to a web page from the web site. Specification, page 2, lines 5-6.

The data included in the cookies may then be gathered by data collection agencies and stored in a database. Specification, page 2, lines 7-8. For example, if a user purchased vintage baseball cards on a web site that sold collectibles, then the cookies may include information such as the name of the individual purchasing the vintage baseball cards, the individual's credit card number, the individual's address and home phone number, the individual's work phone number, as well as the particular type of baseball cards purchased and the amount purchased. Specification, page 2, lines 8-13. The information may then be sold to marketers who use the information to solicit appropriate sales literature, e.g., baseball cards, to the individual. Specification, page 2, lines 13-14. However, the individual may not want marketers to obtain such information. Specification, page 2, lines 14-15.

Furthermore, the data in the cookies that are used to deduce the user's interest or buying habits may be inaccurate. Specification, page 2, lines 16-17. For example, a user may be researching Islamic holidays on the Internet because of a school project. Marketers may then make improper deducements from the cookie data, e.g., the user is an Islamic fundamentalist and would like literature on how to join Islamic fundamentalist political parties and organizations. Specification, page 2, lines 17-20.

Therefore, there is a need in the art to improve accuracy of the data gathered by data collection agencies and distributed to marketers. Specification, page 2, lines 22-23. There is a further need in the art to limit the information that may become available to data collection agencies and sold to marketers if the user wishes. Specification, page 2, lines 23-24.

The problems outlined above may at least in part be solved in some embodiments by a user of a client in a network system sending a particular persona facet comprising user selectable information to the web site during the electronic transaction. Specification, page 4, lines 2-4. A persona facet may be characterized as a facet of a persona object representing a facet of an individual's personalities, traits or interests. Specification, page 4, lines 4-6. Upon the web site recognizing the particular persona facet, the user may request the web site to send information, e.g.,

information used to deduce the user's interest or buying habits, about the user stored in a database, e.g., consumer resource management database. Specification, page 4, lines 6-9. Upon receipt of the information about the user from the web site, a comparison may then be made between the received information from the web site and the user selectable information in the particular persona facet. Specification, page 4, lines 9-12. If there are any differences, the database, e.g., consumer resource management database, may then be updated so that the database, e.g., consumer resource management database, only includes the user selected information. Specification, page 4, lines 12-14.

In one embodiment, a method for controlling information gathered by data collection agencies in an electronic transaction comprises the step of selecting a persona facet where the selected persona facet comprises user selectable information, e.g., name, e-mail address, unique key, public key, private key, payment method, consumer resource data, that will be exposed in the electronic transaction. Specification, page 4, lines 16-20. The user of a client in a network system may then connect to a web site via a web browser. Specification, page 4, lines 20-21. Upon initiating an electronic transaction, the user may send the selected persona facet to the web site. Specification, page 4, lines 21-22. If the web site recognizes the persona facet, then the user may request the web site to send the information about the user stored in a database, e.g., consumer resource management database. Specification, page 4, lines 22-25. If the web site sends the information, then the user may compare the received information with the user selectable information in the selected persona facet. Specification, page 4, lines 25-26. If there are any differences between the received information and the user selectable information in the selected persona facet, then the database, e.g., consumer resource management database, may then be updated to include only the user selectable information. Specification, page 4, line 26 – Specification, page 5, line 3. By updating the database, e.g., consumer resource management database, the information gathered by data collection agencies and distributed to marketers may be more accurate as well as limited according to the user's wishes. Specification, page 5, lines 3-6. Upon updating the database, e.g.,

consumer resource management database, the electronic transaction may be completed. Specification, page 5, lines 6-7.

In another embodiment of the present invention, the electronic transaction may be completed by the web browser initiating a method call to the web site to expose the particular method of payment, e.g., credit card number. Specification, page 5, lines 8-10. In this manner, the user does not send the particular payment method, e.g., credit card number, over the Internet, thereby improving secrecy and reducing chances of fraud and identity theft. Specification, page 5, lines 10-12.

VI. ISSUES

A. Are claims 1-7, 13-19 and 25-31 properly rejected under 35 U.S.C. §102(e) as being anticipated by Koeppel et al. (U.S. Patent No. 6,477,575) (hereinafter "Koeppel")?

B. Are claims 8-9, 20-21 and 32-33 properly rejected under 35 U.S.C. §103(a) as being unpatentable over Koeppel in view of Franklin et al. (U.S. Patent No. 6,125,352) (hereinafter "Franklin")?

C. Are claims 10-12, 22-24 and 34-36 properly rejected under 35 U.S.C. §103(a) as being unpatentable over Koeppel in view of Jaye et al. (U.S. Patent No. 6,415,322) (hereinafter "Jaye")?

VII. GROUPING OF CLAIMS

Claims 1, 7, 13, 19, 25 and 31 form a first group.

Claims 2, 14 and 26 form a second group.

Claims 3, 15 and 27 form a third group.

Claims 4, 16 and 28 form a fourth group.

Claims 5, 17 and 29 form a fifth group.

Claims 6, 18 and 30 form a sixth group.

Claims 8, 20 and 32 form a seventh group.

Claims 9, 21 and 33 form an eighth group.

Claims 10, 22 and 34 form a ninth group.

Claims 11, 23 and 35 form a tenth group.

Claims 12, 24 and 36 form an eleventh group.

The reasons for these groupings are set forth in Appellant's arguments in Section VIII.

VIII. ARGUMENT

A. **Claims 1-7, 13-19 and 25-31 are not properly rejected under 35 U.S.C. §102(e) as being anticipated by Koeppel.**

For a claim to be anticipated under 35 U.S.C. § 102, each and every claim limitation must be found within the cited prior art reference and arranged as required by the claim. M.P.E.P. § 2131.

Appellant respectfully asserts that Koeppel does not disclose "selecting a persona facet by a user, wherein said persona facet selected comprises a user selectable information selected by the user to be exposed in said electronic transaction" as recited in claim 1 and similarly in claims 13 and 25. The Examiner cites column 7, lines 31-34 and column 11, lines 21-52 of Koeppel as disclosing the above-cited claim limitation. Paper No. 9, pages 2 and 3. Appellant respectfully traverses and asserts that Koeppel instead discloses monitoring and storing client activities such as browsing through a web page, making link selections on a web page to other pages, mouse movements, screen scrolling, window resizing, or any other user initiated event. Koeppel further discloses that a user performs activities such as screen scrolling, mouse movements, page resizing and link selections associated with web browsing. This language is not the same as user selectable information selected by the user to be exposed in an electronic transaction. The user in Koeppel does not select the information that is monitored and stored in the client side data store.

Furthermore, Koeppel does not disclose that this information will be exposed in an electronic transaction, but instead it is used by marketing agencies to develop better advertisements aimed toward this particular user. The Examiner responds by stating that browsing a web page and selecting a link results in an electronic transaction. Paper No. 9, page 2. Appellant traverses the implied assertion that

browsing a web page and selecting a link discloses user selectable information that will be exposed in an electronic transaction. The Examiner has not cited to any passage in Koeppel nor offered any objective evidence for asserting that Koeppel discloses user selectable information that will be exposed in an electronic transaction. The Examiner bears the initial burden and must submit objective evidence and not rely on her own subjective opinion in support of a *prima facie* case of anticipation. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). The Examiner is reminded that in order to establish a *prima facie* case of anticipation, the Examiner must submit a reference that discloses each and every claim limitation. M.P.E.P. §2131.

Further, Koeppel does not disclose a persona facet. The Examiner states a persona facet corresponds to information browsed during the web browsing. Paper No. 9, page 2. The Examiner has not cited to any particular passage in Koeppel nor offered any objective evidence that information browsed during web browsing comprises is the same as a persona facet that includes information selected by the user to be exposed in an electronic transaction. The Examiner bears the initial burden and must submit objective evidence and not rely on her own subjective opinion in support of a *prima facie* case of anticipation. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). The Examiner is reminded that in order to establish a *prima facie* case of anticipation, the Examiner must submit a reference that discloses each and every claim limitation. M.P.E.P. §2131.

Therefore, Koeppel does not disclose all the limitations of claims 1, 13 and 25, and thus Koeppel does not anticipate claims 1, 13 and 25. M.P.E.P. § 2131.

Appellant further asserts that Koeppel does not disclose "sending said selected persona facet to said web site by said web browser during said electronic transaction" as recited in claim 1 and similarly in claims 13 and 25. The Examiner cites column 11, line 21 through column 12, line 30 and Figures 2-3 and 5-6 of Koeppel as disclosing the above-cited claim limitation. Paper No. 9, page 4. Appellant traverses and respectfully asserts that Koeppel instead discloses monitoring and storing user initiated events such as browsing through a web page, mouse movements, screen

scrolling and linking to other web pages. Further, Koeppel discloses that upon a trigger event, e.g., client side data store being filled up to a threshold limit, the information stored in the client side data store is transmitted to the web server and is consequently forwarded to a data store for storage. The information stored in the data store is then used by the server to update the marketing information. As stated above, Koeppel does not disclose a persona facet and therefore does not disclose sending a persona facet. Furthermore, Koeppel discloses transmitting the information stored in the client side data store to the server upon initiating the trigger event. This language is not the same as sending a persona facet during an electronic transaction. Therefore, Koeppel does not disclose all the limitations of claims 1, 13 and 25, and thus Koeppel does not anticipate claims 1, 13 and 25. M.P.E.P. § 2131.

Appellant further asserts that Koeppel does not disclose "receiving information about said user stored in a database from said web site if said web site recognizes said persona facet" as recited in claim 1 and similarly in claims 13 and 25. The Examiner cites column 11, line 21 through column 12, line 30 and Figures 2-3 and 5-6 of Koeppel as disclosing the above-cited claim limitation. Paper No. 9, page 4. Appellant respectfully traverses. As stated above, Koeppel discloses monitoring and storing user initiated events such as browsing through a web page, mouse movements, screen scrolling and linking to other web pages. Further, Koeppel discloses that upon a trigger event, e.g., client side data store being filled up to a threshold limit, the information stored in the client side data store is transmitted to the web server. There is no determination as to whether the server recognizes a persona facet in order to determine whether to receive information about the user stored in a database. Therefore, Koeppel does not disclose all the limitations of claims 1, 13 and 25, and thus Koeppel does not anticipate claims 1, 13 and 25. M.P.E.P. § 2131.

Appellant further asserts that Koeppel does not disclose "updating said information about said user stored in said database" as recited in claim 1 and similarly in claims 13 and 25. The Examiner cites column 11, line 21 through column 12, line 60 and Figures 2-3 and 5-6 of Koeppel as disclosing the above-cited claim limitation. Paper No. 9, page 4. Appellant respectfully traverses. As stated above, Koeppel

discloses monitoring and storing user initiated events such as browsing through a web page, mouse movements, screen scrolling and linking to other web pages. Further, Koeppel discloses that upon a trigger event, e.g., client side data store being filled up to a threshold limit, the information stored in the client side data store is transmitted to the web server. Koeppel further discloses that the information received by the web server is forwarded to a data store for storage. That information is then used by a marketing agency to perform marketing analysis on the content rendered to the client nodes. Koeppel simply discloses storing the received information on the user behavior in a data store for storage. This is not the same as updating the information about the user in a database. Therefore, Koeppel does not disclose all the limitations of claims 1, 13 and 25, and thus Koeppel does not anticipate claims 1, 13 and 25. M.P.E.P. § 2131.

Appellant further asserts that Koeppel does not disclose "comparing said user selectable information in said persona facet with said received information from said web site" as recited in claim 2 and similarly in claims 14 and 26. The Examiner cites column 11, line 21 through column 12, line 60 and Figures 2-3 and 5-6 of Koeppel as disclosing the above-cited claim limitation. Paper No. 9, page 4. Appellant respectfully traverses and asserts that the cited passage instead discloses transmitting information about the user's behavior to the server which is forwarded to the data store for storage. An analytical program may then be used to analyze the user's behavior information that is stored in the data store to determine whether the web page rendered at each client with its associated client needs adjustment based on the collected user response data. This language does not disclose user selectable information. Furthermore, as stated above, Koeppel does not disclose a persona facet. Furthermore, this language does not disclose comparing user selectable information in a persona facet with the received information from the web site. The cited passage does not disclose any type of comparing but instead discloses analyzing information on the user's behavior using an analytical program. Therefore, Koeppel does not disclose all the limitations of claims 2, 14 and 26, and thus Koeppel does not anticipate claims 2, 14 and 26. M.P.E.P. § 2131.

Appellant further asserts that Koeppel does not disclose "wherein said comparing said user selectable information in said persona facet with said received information from said web site comprises the step of parsing said information received from said web site" as recited in claim 3 and similarly in claims 15 and 27. The Examiner cites column 11, line 21 through column 12, line 60 and Figures 2-3 and 5-6 of Koeppel as disclosing the above-cited claim limitation. Paper No. 9, page 4. Appellant respectfully traverses and asserts that that cited passages instead discloses the web server receiving information on the user's behavior that is transmitted to a data store for storage. The information on the user's behavior stored in the data store is then analyzed by an analytical program. This language is not the same as parsing information received from a web site. Appellant has performed a word search of "parsing" in Koeppel and has been unable to identify the word "parsing" or any variation thereof. Therefore, Koeppel does not disclose all the limitations of claims 3, 15 and 27, and thus Koeppel does not anticipate claims 3, 15 and 27. M.P.E.P. § 2131.

Appellant further asserts that Koeppel does not disclose "wherein said web site determines if said web site recognizes said persona facet by searching a database for said persona facet" as recited in claim 4 and similarly in claims 16 and 28. The Examiner cites column 12, lines 15-60 and Figures 5-6 of Koeppel as disclosing the above-cited claim limitation. Paper No. 9, page 4. Appellant respectfully traverses and asserts that Koeppel instead discloses that the information about the user's behavior is transmitted to the server which is then forwarded to a data store for storage. The information about the user's behavior stored in the data store may subsequently be analyzed by an analytical program to determine whether the web page rendered at each client node with its associated content needs adjustment. This language does not disclose the web site determining if the web site recognizes a persona facet by searching a database for the persona facet. Therefore, Koeppel does not disclose all the limitations of claims 4, 16 and 28, and thus Koeppel does not anticipate claims 4, 16 and 28. M.P.E.P. § 2131.

Appellant further asserts that Koeppel does not disclose "wherein if there are differences between said information received from said web site and said user selectable information in said persona facet from said comparison then said information about said user stored in said database is updated" as recited in claim 5 and similarly in claims 17 and 29. The Examiner cites column 12, lines 31-60 and column 13, lines 22-28 of Koeppel as disclosing the above-cited claim limitation. Paper No. 9, page 5. Appellant respectfully traverses and asserts that Koeppel instead discloses using an analytical program to analyze the information about the user's behavior stored in the data store to determine whether the web page rendered at each client node with its associated content needs adjustment. The analytical program may apply a number of different rules associated with each response data characteristic to determine what type of changes, if any, are needed to the content and content rules stored in a separate data store. The cited language is not the same as updating the information about the user stored in the database if there are differences between the information received from the web site and the user selectable information in the persona facet. Therefore, Koeppel does not disclose all the limitations of claims 5, 17 and 29, and thus Koeppel does not anticipate claims 5, 17 and 29. M.P.E.P. § 2131.

Appellant further asserts that Koeppel does not disclose "completing said electronic transaction" as recited in claim 6 and similarly in claims 18 and 30. The Examiner cites column 13, lines 22-28 of Koeppel as disclosing the above-cited claim limitation. Paper No. 9, page 5. Appellant respectfully traverses and asserts that Koeppel instead discloses an analytical program that applies a number of different rules associated with each response data characteristic to determine what changes, if any, are needed to the content and content rules stored in a data store unit. This language is not the same as completing an electronic transaction. Therefore, Koeppel does not disclose all the limitations of claims 6, 18 and 30, and thus Koeppel does not anticipate claims 6, 18 and 30. M.P.E.P. § 2131.

As a result of the foregoing, Appellant respectfully asserts that not each and every claim limitation was found within the cited prior art reference, and thus claims 1-7, 13-19 and 25-31 are not anticipated by Koeppel.

B. Claims 8-9, 20-21 and 32-33 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Koeppel in view of Franklin.

1. Koeppel and Franklin, taken singly or in combination, do not teach or suggest the following claim limitations.

Appellant respectfully asserts that Koeppel and Franklin, taken singly or in combination, do not teach or suggest "wherein said electronic transaction is completed by initiating a method call to said web site from said web browser to expose said particular payment method" as recited in claim 9 and similarly in claims 21 and 33. The Examiner cites column 17, lines 62-67 and column 24, line 61 through column 25, line 11 and FIG. 4 of Franklin as teaching the above-cited claim limitation. Paper No. 9, page 5. Appellant respectfully traverses and asserts that Franklin instead teaches transmitting encrypted payment information to the merchant web site. This language does not teach initiating a method call to the web site to expose the particular payment method. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

2. The Examiner has not provided any objective evidence for combining Koeppel with Franklin.

A *prima facie* showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art reference to make the claimed inventions. M.P.E.P. §2142. The showings must be clear and particular. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002); *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

In order to reject under 35 U.S.C. § 103, therefore, the Examiner must provide a proper motivation for combining or modifying the references. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457-1458 (Fed. Cir. 1998); M.P.E.P. § 2142. The Examiner's motivation for modifying Koeppel with Franklin to include user selectable information that comprises a particular payment method, as recited in claims 8, 20 and 32, as well as modifying Koeppel with Franklin to complete an electronic transaction by initiating a method call to a web site from the web browser to expose a particular payment method, as recited in claims 9, 21 and 33, is "because it would expand usages of the electronic transaction method of Koeppel, in particular for applying it for payment transaction." Paper No. 9, pages 5-6. This motivation is insufficient to support a *prima facie* case of obviousness, since it is merely the Examiner's subjective opinion.

Koeppel teaches transmitting information on a user's behavior to the server which may then be forwarded to a data store unit for storage. Column 5, lines 34-52; Column 12, lines 15-25 and lines 38-51. The information stored in the data store unit may then be analyzed by an analytical program to determine whether the web page rendered each client node with its associated content needs adjustment. Column 5, lines 34-52; Column 12, lines 15-25 and lines 38-51.

Franklin, on the other hand, teaches adding various client-side functionality for allowing user's to store, view and process product information, payment information and shipping information on the user computer. Column 2, lines 29-53.

The Examiner must submit objective evidence and not rely on her own subjective opinion in support of combining the reference that teaches analyzing information about a user's behavior to reflect the success of the content presented in the web page with a reference that teaches adding various client-side functionality for allowing user's to store, view and process product information, payment information and shipping information on the user computer. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Further, the Examiner must submit objective evidence and not rely on her own subjective opinion in support of modifying Koeppel to include user

selectable information that comprises a particular payment method. *Id.* Further, the Examiner must submit objective evidence and not rely on her own subjective opinion in support of modifying Koeppel to complete an electronic transaction by initiating a method call to a web site from the web browser to expose a particular payment method. *Id.* Further, the Examiner must submit objective evidence and not rely on her own subjective opinion in support of modifying Koeppel to expand usages of the electronic transaction. *Id.*

In response to Appellant's assertion that the Examiner must submit objective evidence, the Examiner alleges that the motivation for modifying Koeppel with Franklin to include user selectable information that comprises a particular payment method, as recited in claims 8, 20 and 32, as well as the motivation for modifying Koeppel with Franklin to complete an electronic transaction by initiating a method call to a web site from the web browser to expose a particular payment method, as recited in claims 9, 21 and 33, comes from one of ordinary skill in the art. Paper No. 9, page 3. While the motivation may come from one of ordinary skill in the art, the Examiner must still provide objective evidence as to why one of ordinary skill in the art would have been motivated to modify Koeppel with Franklin and to combine them to render the claimed invention obvious. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002); *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). As the Examiner is simply relying upon her own subjective opinion and has not provided any objective evidence, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 8-9, 20-21 and 32-33. M.P.E.P. §2142.

As a result of the foregoing, Applicant respectfully asserts that the Examiner's *prima facie* case of obviousness is not taught or suggested by the cited prior art since there are numerous claim limitations not taught or suggested in the cited prior art, and thus one skilled in the art would not have been able to recreate claims 8-9, 20-21 and 32-33 in view of the cited prior art.

C. Claims 10-12, 22-24 and 34-36 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Koeppel in view of Jaye.

1. Koeppel and Jaye, taken singly or in combination, do not teach or suggest the following claim limitations.

Appellant respectfully asserts that Koeppel and Jaye, taken singly or in combination, do not teach or suggest "determining whether said selected persona facet is recognized by said web site, wherein if said web site does not recognize said selected persona facet then said user selectable information is stored in cookie data" as recited in claim 10 and similarly in claims 22 and 34. The Examiner cites column 6, lines 12 – column 7, line 45 and Figure 2 of Jaye as teaching the above-cited claim limitation. Paper No. 9, page 6. Appellant respectfully traverses and asserts that Jaye instead teaches that if the client does not provide a cookie with the data request to a local server then it is assumed that the client never accessed the local server and the local server creates a unique ID for the client. This language is not the same as "determining whether the selected persona facet is recognized by the web site. Instead, Jaye teaches determining if the client provided a cookie along with the data request. Further, this language does not teach that if the web site does not recognize the selected person facet then the user selectable information is stored in cookie data. Instead, Jaye teaches that if the client does not send a cookie along with the data request then the local server creates a unique ID for the client. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Appellant further asserts that Koeppel and Jaye, taken singly or in combination, do not teach or suggest "determining whether said selected persona facet is recognized by said web site, wherein if said web site recognizes said selected persona facet then said user requests from said web site to send said information about said user stored in said database" as recited in claim 11 and similarly in claims 23 and 35. The Examiner cites column 6, lines 12 – column 7, line 45 and Figure 2 of Jaye as teaching the above-cited claim limitation. Paper No. 9, page 6. Appellant respectfully traverses. Instead, as stated above, Jaye teaches that if the client does not

provide a cookie with the data request to a local server then it is assumed that the client never accessed the local server and the local server creates a unique ID for the client. This language is not the same as determining whether the selected persona facet is recognized by the web site. Instead, Jaye teaches determining if the client provided a cookie along with the data request. Further, this language does not teach where if the web site recognizes the selected persona facet then the user requests from the web site to send the information about the user stored in the database. Instead, Jaye teaches that if the client does not send a cookie along with the data request then the local server creates a unique ID for the client. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Appellant further asserts that Koeppel and Jaye, taken singly or in combination, do not teach or suggest "wherein if said web site does not send said information about said user stored in said database then the method further comprises the step of: storing said user selectable information in cookie data" as recited in claim 12 and similarly in claims 24 and 36. The Examiner cites column 6, lines 12 – column 7, line 45 and Figure 2 of Jaye as teaching the above-cited claim limitation. Paper No. 9, page 6. Appellant respectfully traverses. Instead, as stated above, Jaye teaches that if the client does not provide a cookie with the data request to a local server then it is assumed that the client never accessed the local server and the local server creates a unique ID for the client. This language is not the same as storing user selectable information in cookie data. Further, this language is not the same as storing user selectable information in cookie data if the web site does not send information about the user stored in the database. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

2. **The Examiner has not provided any objective evidence for combining Koeppel with Jaye.**

As stated above, a *prima facie* showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art reference to make the claimed inventions. M.P.E.P. §2142. The showings must be clear and particular. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002); *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

In order to reject under 35 U.S.C. § 103, therefore, the Examiner must provide a proper motivation for combining or modifying the references. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457-1458 (Fed. Cir. 1998); M.P.E.P. § 2131. The Examiner's motivation for modifying Koeppel with Jaye (1) to determine whether a selected persona facet is recognized by a web site where if the web site does not recognize the selected person facet then the user selectable information is stored in cookie data, as recited in claims 10, 22 and 34; (2) and where if the web site recognizes the selected persona facet then the user requests from the web site to send the information about the user stored in the database, as recited in claims 11, 23 and 35, is "so that the information can be better traced." Paper No. 9, page 6. This motivation is insufficient to support a *prima facie* case of obviousness, since it is merely the Examiner's subjective opinion.

Koeppel teaches transmitting information on a user's behavior to the server which may then be forwarded to a data store unit for storage. Column 5, lines 34-52; Column 12, lines 15-25 and lines 38-51. The information stored in the data store unit may then be analyzed by an analytical program to determine whether the web page rendered each client node with its associated content needs adjustment. Column 5, lines 34-52; Column 12, lines 15-25 and lines 38-51.

Jaye, on the other hand, teaches establishing a global interest profile of a user while protecting the privacy of the user. Column 2, lines 1-11.

The Examiner must submit objective evidence and not rely on her own subjective opinion in support of combining the reference that teaches analyzing information about a user's behavior to reflect the success of the content presented in the web page with a reference that teaches establishing a global interest profile of a user while protecting the privacy of the user. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Further, the Examiner must submit objective evidence and not rely on her own subjective opinion in support of modifying Koeppel to determine whether a selected persona facet is recognized by a web site where if the web site does not recognize the selected persona facet then the user selectable information is stored in cookie data. *Id.* Further, the Examiner must submit objective evidence and not rely on her own subjective opinion in support of modifying Koeppel where if the web site recognizes the selected persona facet then the user requests from the web site to send the information about the user stored in the database. *Id.* Further, the Examiner must submit objective evidence and not rely on her own subjective opinion in support of modifying Koeppel so that information can be better traced. *Id.*

Therefore, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 10-12, 22-24 and 34-36. M.P.E.P. §2142.

As a result of the foregoing, Applicant respectfully asserts that the Examiner's *prima facie* case of obviousness is not taught or suggested by the cited prior art since there are numerous claim limitations not taught or suggested in the cited prior art, and thus one skilled in the art would not have been able to recreate claims 10-12, 22-24 and 34-36 in view of the cited prior art.

IX. CONCLUSION

For the reasons noted above, the rejections of claims 1-36 are in error. Appellant respectfully requests reversal of the rejections and allowance of claims 1-36.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Appellant

By: _____

Robert A. Voigt, Jr.

Reg. No. 47,159

Kelly K. Kordzik

Reg. No. 36,571

P.O. Box 50784
400 North Ervay Street
Dallas, Texas 75201
(512) 370-2832

APPENDIX

1 1. A method for controlling information gathered by data collection agencies in
2 an electronic transaction comprising the steps of:

3 selecting a persona facet by a user, wherein said persona facet selected
4 comprises a user selectable information selected by the user to be exposed in said
5 electronic transaction;

6 connecting to a web site by a web browser;

7 sending said selected persona facet to said web site by said web browser
8 during said electronic transaction;

9 receiving information about said user stored in a database from said web site
10 if said web site recognizes said persona facet; and

11 updating said information about said user stored in said database.

1 2. The method as recited in claim 1 further comprising the step of:

2 comparing said user selectable information in said persona facet with said
3 received information from said web site.

1 3. The method as recited in claim 2, wherein said comparing said user selectable
2 information in said persona facet with said received information from said web site
3 comprises the step of parsing said information received from said web site.

1 4. The method as recited in claim 1, wherein said web site determines if said
2 web site recognizes said persona facet by searching a database for said persona facet.

1 5. The method as recited in claim 2, wherein if there are differences between
2 said information received from said web site and said user selectable information in
3 said persona facet from said comparison then said information about said user stored
4 in said database is updated.

1 6. The method as recited in claim 1 further comprising the step of:

2 completing said electronic transaction.

1 7. The method as recited in claim 1, wherein said user selectable information
2 comprises at least one of the following: user name, electronic mail address, public
3 key, private key, unique key, payment method, and customer resource data.

1 8. The method as recited in claim 6, wherein said user selectable information
2 comprises a particular payment method.

1 9. The method as recited in claim 8, wherein said electronic transaction is
2 completed by initiating a method call to said web site from said web browser to
3 expose said particular payment method.

1 10. The method as recited in claim 1 further comprising the step of:
2 determining whether said selected persona facet is recognized by said web
3 site, wherein if said web site does not recognize said selected persona facet then said
4 user selectable information is stored in cookie data.

1 11. The method as recited in claim 1 further comprising the step of:
2 determining whether said selected persona facet is recognized by said web
3 site, wherein if said web site recognizes said selected persona facet then said user
4 requests from said web site to send said information about said user stored in said
5 database.

1 12. The method as recited in claim 11, wherein if said web site does not send said
2 information about said user stored in said database then the method further comprises
3 the step of:
4 storing said user selectable information in cookie data.

1 13. A computer program product having computer readable medium having
2 computer program logic recorded thereon for controlling information gathered by
3 data collection agencies in an electronic transaction, comprising:

4 programming operable for selecting a persona facet by a user, wherein said
5 persona facet selected comprises a user selectable information selected by the user to
6 be exposed in said electronic transaction;

7 programming operable for connecting to a web site by a web browser;

8 programming operable for sending said selected persona facet to said web site
9 by said web browser during said electronic transaction;

10 programming operable for receiving information about said user stored in a
11 database from said web site if said web site recognizes said persona facet; and

12 programming operable for updating said information about said user stored in
13 said database.

1 14. The computer program product as recited in claim 13 further comprises:

2 programming operable for comparing said user selectable information in said
3 persona facet with said received information from said web site.

1 15. The computer program product as recited in claim 14, wherein said comparing
2 said user selectable information in said persona facet with said received information
3 from said web site comprises:

4 programming operable for parsing said information received from said web
5 site.

1 16. The computer program product as recited in claim 13, wherein said web site
2 determines if said web site recognizes said persona facet by searching a database for
3 said persona facet.

1 17. The computer program product as recited in claim 14, wherein if there are
2 differences between said information received from said web site and said user
3 selectable information in said persona facet from said comparison then said
4 information about said user stored in said database is updated.

1 18. The computer program product as recited in claim 13 further comprises:

2 programming operable for completing said electronic transaction.

1 19. The computer program product as recited in claim 13, wherein said user
2 selectable information comprises at least one of the following: user name, electronic
3 mail address, public key, private key, unique key, payment method, and customer
4 resource data.

1 20. The computer program product as recited in claim 18, wherein said user
2 selectable information comprises a particular payment method.

1 21. The computer program product as recited in claim 20, wherein said electronic
2 transaction is completed by initiating a method call to said web site from said web
3 browser to expose said particular payment method.

1 22. The computer program product as recited in claim 13 further comprises:
2 programming operable for determining whether said selected persona facet is
3 recognized by said web site, wherein if said web site does not recognize said selected
4 persona facet then said user selectable information is stored in cookie data.

1 23. The computer program product as recited in claim 13 further comprises:
2 programming operable for determining whether said selected persona facet is
3 recognized by said web site, wherein if said web site recognizes said selected persona
4 facet then said user requests from said web site to send said information about said
5 user stored in said database.

1 24. The computer program product as recited in claim 23, wherein if said web site
2 does not send said information about said user stored in said database then the
3 computer program product further comprises:
4 programming operable for storing said user selectable information in cookie
5 data.

1 25. A system comprising:
2 a processor;
3 a memory unit operable for storing a computer program operable for
4 controlling information gathered by data collection agencies in an electronic
5 transaction; and
6 a bus system coupling the processor to the memory, wherein the computer
7 program is operable for performing the following programming steps:

8 selecting a persona facet by a user, wherein said persona facet selected
9 comprises a user selectable information selected by the user to be exposed in said
10 electronic transaction;

11 connecting to a web site by a web browser;

12 sending said selected persona facet to said web site by said web
13 browser during said electronic transaction;

14 receiving information about said user stored in a database from said
15 web site if said web site recognizes said persona facet; and

16 updating said information about said user stored in said database.

1 26. The system as recited in claim 25, wherein the computer program is further
2 operable to perform the programming step:

3 comparing said user selectable information in said persona facet with said
4 received information from said web site.

1 27. The system as recited in claim 26, wherein said comparing said user selectable
2 information in said persona facet with said received information from said web site
3 comprises the programming step:

4 parsing said information received from said web site.

1 28. The system as recited in claim 25, wherein said web site determines if said
2 web site recognizes said persona facet by searching a database for said persona facet.

1 29. The system as recited in claim 26, wherein if there are differences between
2 said information received from said web site and said user selectable information in
3 said persona facet from said comparison then said information about said user stored
4 in said database is updated.

1 30. The system as recited in claim 25, wherein the computer program product is
2 further operable to perform the programming step:

3 completing said electronic transaction.

1 31. The system as recited in claim 25, wherein said user selectable information
2 comprises at least one of the following: user name, electronic mail address, public
3 key, private key, unique key, payment method, and customer resource data.

1 32. The system as recited in claim 30, wherein said user selectable information
2 comprises a particular payment method.

1 33. The system as recited in claim 32, wherein said electronic transaction is
2 completed by initiating a method call to said web site from said web browser to
3 expose said particular payment method.

1 34. The system as recited in claim 25, wherein the computer program is further
2 operable to perform the programming step:

3 determining whether said selected persona facet is recognized by said web
4 site, wherein if said web site does not recognize said selected persona facet then said
5 user selectable information is stored in cookie data.

1 35. The system as recited in claim 25, wherein the computer program is further
2 operable to perform the programming step:

3 determining whether said selected persona facet is recognized by said web
4 site, wherein if said web site recognizes said selected persona facet then said user
5 requests from said web site to send said information about said user stored in said
6 database.

1 36. The system as recited in claim 35, wherein if said web site does not send said
2 information about said user stored in said database then the computer program is
3 further operable to perform the programming step:

4 storing said user selectable information in cookie data.



US 2000-0591-US1

PATENT

AF/3621
\$

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: David B. Kumhyr
Serial No.: 09/731,628 Art Unit: 3621
Filed: December 7, 2000 Examiner: Mary Cheung
For: USE OF PERSONA OBJECT IN ELECTRONIC TRANSACTIONS

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION - 37 CFR 1.192)

RECEIVED
DEC 18 2003
GROUP 3600

1. Transmitted herewith in triplicate is the APPEAL BRIEF in this application with respect to the Notice of Appeal filed on October 28, 2003.

NOTE: "The appellant shall, within 2 months from the date of the notice of appeal under § 1.191 in an application, reissue application, or patent under reexamination, or within the time allowed for response to the action appealed from, if such time is later, file a brief in triplicate." 37 CFR 1.192(a) (emphasis added).

2. STATUS OF APPLICANT

This application is on behalf of

☒ other than a small entity

☐ small entity

verified statement:

☐ attached

☐ already filed

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 CFR 1.17(f) the fee for filing the Appeal Brief is:

☐ small entity \$165.00

☒ other than a small entity \$330.00

Appeal Brief fee due \$330.00

CERTIFICATE OF MAILING (37 CFR § 1.8)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date:

12/11/03

Serena Beller

(Type or print name of person mailing paper)

Serena Beller

(Signature of person mailing paper)

4. EXTENSION OF TERM

NOTE: The time periods set forth in 37 CFR 1.192(a) are subject to the provision of § 1.136 for patent applications. 37 CFR 1.191(d). Also see Notice of November 5, 1985 (1060 O.G. 27).

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136 apply.

(complete (a) or (b) as applicable)

- (a) ☐ Applicants petition for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

Extension (months)	Fee for other than small entity	Fee for small entity
<input type="checkbox"/> one month	\$ 110.00	\$ 55.00
<input type="checkbox"/> two months	\$ 410.00	\$ 205.00
<input type="checkbox"/> three months	\$ 930.00	\$ 465.00
<input type="checkbox"/> four months	\$ 1,450.00	\$ 725.00
Fee		

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

- ☐ An extension for _____ months has already been secured and the fee paid therefor of \$ _____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ _____

or

- (b) ☒ Applicants believe that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicants have inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE

The total fee due is:

Appeal Brief fee \$330.00

Extension fee (if any) \$0

TOTAL FEE DUE \$330.00

6. FEE PAYMENT

- ☐ Attached is a check in the sum of \$ _____

- ☒ Charge Account No. 09-0447 (AUS9-2000-0591-US1) the sum of \$330.00.

A duplicate of this transmittal is attached.

7. FEE DEFICIENCY

NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, 1065 O.G. 31-33.

- ☒ If any additional extension and/or fee is required, this is a request therefor and to charge Account No. 09-0447 (AUS9-2000-0591-US1).

AND/OR

- ☒ If any additional fee for claims is required, charge Account No. 09-0447 (AUS9-2000-0591-US1)

Reg. No.: 47,159


SIGNATURE OF ATTORNEY

Tel. No.: (512) 370-2832

Robert A. Voigt, Jr.
WINSTEAD SECHREST & MINICK P.C.
P.O. Box 50784
400 North Ervay Street
Dallas, TX 75201

AUSTIN_1\238503\1
7047-P379US